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| 10/603,517      | 06/25/2003  | Herman F. George     | 3242                | 3982             |

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## THE LUBRIZOL CORPORATION

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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/603,517

Applicant(s)

GEORGE ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/3/05; 6/25/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/603,644. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additive composition comprising a dispersant, antioxidant, and other additives including a detergent may be the same and may be in the form of a gel as disclosed in the specification on page 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10-21 of copending Application No. 10/603,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions of the co-pending application comprising one or more fuel additives in the form of a gel may be the same as the

claims in this application. Although it is recognized that lubricant and fuel compositions are distinct, the compositions do not require the addition of a fuel and may contain the same components, namely a dispersant, a detergent and an antioxidant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/964,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant additive package and oil filter of the copending application may contain the same components as the additive composition and oil filter of this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al (6,268,316), Ogano et al (6,207,625), Goldblatt et al (6,187,721), Fang et al (5,837,657) and Gao (6,689,725), considered separately.

Tanaka et al ["Tanaka"] disclose internal combustion engine lubricating compositions comprising a basestock, (A) an organic molybdenum compound, (B) a succinimide which acts as a dispersant in an amount of 0.5% to 25% by weight, and (C) a zinc dithiophosphate which has antioxidant properties in an amount of 0.001 to 3% by weight. The compositions act to disperse the soot produced by combustion in diesel engines which enters the engine oil and, thus, prevents the oil from exercising its lubricity. Tanaka allows for the addition of other additives to the lubricating composition including metal detergents, additional ashless dispersants, phenol-based antioxidants and amine-based antioxidants. See columns 6 and 11-12. The open-ended "additive composition" of independent claim 1 may include other components in major amounts such as base oils. Thus, the examiner is of the position that Tanaka anticipates the above rejected claims.

Ogano et al ["Ogano"] disclose lubricating oil compositions comprising a mineral or synthetic base oil, (A) a sulfurized oxymolybdenum dithiocarbamate, and (B) zinc dithiophosphate, which may be used as diesel engine lubricants operating with large quantities of soot in the engine oil. Ogano allows for the addition of conventional lubricant additives to the compositions including viscosity index improver, pour point depressant, ashless dispersant, metallic detergent and antioxidant. See column 6, line 18 to column 7, line 45, where specific components are set forth. The open-ended "additive composition" of independent claim 1 may

include other components in major amounts such as base oils. Thus, the examiner is of the position that Ogano anticipates the above rejected claims.

Goldblatt et al ["Goldblatt"] discloses that soot in lubricated diesel engines is effectively dispersed without adversely affecting the viscosity of the lubricant by using as the engine oil a composition which comprises a lubricant base stock, a dispersant, a functionalized viscosity index improver and other conventional additives. Suitable conventional additives include detergents, extreme pressure/antiwear agents, oxidation inhibitors, and other minor additives. See column 4, lines 59-64. The open-ended "additive composition" of independent claim 1 may include other components in major amounts such as base oils. Thus, the examiner is of the position that Goldblatt anticipates the above rejected claims.

Fang et al ["Fang"] disclose a method for improving the performance of a sooted diesel oil and for controlling soot induced viscosity increase by adding to a major amount of diesel oil a minor amount of a composition comprising a molybdenum compound of the formula  $\text{Mo}_3\text{S}_k\text{L}_n\text{Q}_z$ . Fang teaches that other known additives may be compatible with the invention and can be present in the diesel oil being treated. Such additives include dispersants, detergents, pour point depressants, and antioxidants. See column 5, lines 62-68. The open-ended "additive composition" of independent claim 1 may include other components in major amounts such as base oils. Thus, the examiner is of the position that Fang anticipates the above rejected claims.

Gao discloses a method for controlling the soot induced viscosity increase of a diesel engine lubricant composition comprising a base oil and a dispersant, by including in said lubricant composition an effective amount of an antioxidant. The antioxidant comprises a

dithiocarbamate of a metal selected from antimony, bismuth and mixtures thereof. The antioxidant may optionally contain at least one other compound selected from phenolic and aminic compounds. Gao teaches that the antioxidant acts to prolong the effective performance of the dispersant additive, thus improving the dispersancy retention capability of the lubricant. See column 1, lines 6-63. Amounts are disclosed in columns 4-5 and include 0.05 to about 3 wt.% of the antimony or bismuth dithiocarbamate, 0.1 to about 3 wt.% of the optional phenolic and/or aminic compounds, and 1 to 10% by weight of the dispersant component. Gao teaches that the lubricating compositions may optionally include antiwear agents, detergents, viscosity index improvers, and other additives. The open-ended "additive composition" of independent claim 1 may include other components in major amounts such as base oils. Thus, the examiner is of the position that Gao anticipates the above rejected claims.

### ***Claim Rejections - 35 USC § 102***

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Burrington et al (6,843,916).

Burrington et al ["Burrington"] disclose a lubricant additive gel formed by the gellation of two or more lubricant additives for the slow release of the additive components into a fluid such as hydrocarbon oil internal combustion engine lubricants. The lubricant additive gels include, but are not limited to those gels formed from combining ashless dispersants such as succinimides, acids, bases and detegents. See column 4, lines 17-28. Additional additives to the gels include viscosity index improvers, extreme pressure agents and antioxidants. See column 8,

lines 22-33. The examiner is of the position that Burrington anticipates the “additive composition” of independent claim 1 which may be in the form of a gel. Burrington also teaches an oil filter for lubricated systems comprising a housing, a filter, and lubricant additives in the form of a gel for slow release into the oil. See the claims. The examiner is of the position that Burrington anticipates the above rejected claims.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

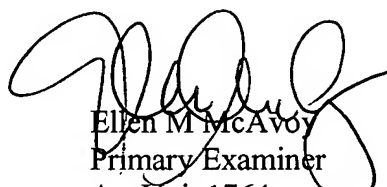
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR



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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
July 15, 2005